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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,252	10/20/2004	Eivind Olav Andersen	TS9284 US	3944

7590

12/01/2005

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EXAMINER

CHOI, LING SIU

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/502,252	Applicant(s) ANDERSEN, EIVIND OLAV	
	Examiner Ling-Siu Choi	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the Amendment filed 08/11/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/20/04, 7/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Amendment filed August 11, 2005. Claims 1-22 are now pending, wherein claims 1-20 are drawn to a pigmentable binder composition; claim 21 a synthetic asphalt; claim 22 a synthetic mastic asphalt. The claim rejections under 35 USC 103 are moved. Since the following rejections are based on a new ground, the present Office Action is made as a second non-final rejection.

Claim Objections

2. Claim 20 is objected to because of the following informalities: **claim 20**, line 5, "all weights" is suggested to be changed to --all % weights--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6 and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 6, lines 2-3; **claims 14-15**, line 2, the recitation "Bright-Stock extract" causes indefiniteness because the extract is defined by a Trade Mark, the content of which can be changed with time. Thus, the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujitani et al. (JP 01-242667).

A pigmentable binder composition comprising	
A	a petroleum resin
B	a lubricating oil and/or a lubricating oil extract
C	0.05-less than 3 wt % of amide additive of the general formula $R^1\text{-CO-NH-(CH}_2\text{)}_x\text{-NH-CO-R}^2$

(summary of claim 1)

Fujitani et al. disclose a composition for road marking material, comprising (A) 10-20 wt% binder resin, (B) 0.5-5 wt% mineral oil, (C) ethylenebisstearic acid amide, and (D) 1-10 wt% coloring pigment, wherein the binder resin can be a maleic acid rosin or a petroleum resin (Means to Solve the Problem). Inclusion of coloring pigments implies that the composition is pigmentable. And "for use in synthetic asphalt" is applicants' intention to use, which does not carry the patentable weight. Thus, the present claims are anticipated by the disclosure of Fujitani et al.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syrier et al. (EP 0 179 510 B1) in view of Janicki (CA 1 260 653).

Syrier et al. disclose a pigmentable binder composition comprising (A) a mineral lubricating oil extract and (B) a petroleum resin, wherein the petroleum resin is modified with carboxylic acid, carboxylic acid anhydride, or hydroxy group (claims 1-9). Syrier et al. further disclose that the binder composition can contain 0.5-10 wt % of wax (page 2, lines 57-61). Syrier et al. furthermore disclose that the pigmentable binder is used to

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form asphaltic composition (page 2, lines 44-46).

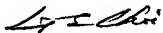
The difference between the present claims and the disclosure of Syrier et al. is the requirement of 0.05-less than 3 wt % of N,N'-alkylenebisstearamide to be used in the present invention.

Janicki discloses that the use of bisstearoylamide is more effective than the use of wax in lowering the viscosity and enabling easier processing (page 1, lines 17-25; page 2, lines 4-12; page 3, lines 2-9). In light of such benefits, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adapt bisstearoylamide in the disclosure of Janicki and thereby obtain the present invention.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-1098.

If attempt to reach the examiner by telephone are unsuccessful, the examiner=s supervisor, David Wu, can be reach on 571-272-1114.



LING-SUI CHOI
PRIMARY EXAMINER

November 22, 2005